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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,206	08/06/2007	Dong Wang	514572001600	8114
25225 7590 11/18/2009 MORRISON & FOERSTER LLP 12531 HIGH BLUFF DRIVE SUITE 100 SAN DIEGO, CA 92130-2040				
EXAMINER				
SISSON, BRADLEY L				
ART UNIT		PAPER NUMBER		
1634				
MAIL DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/568,206

Applicant(s)

WANG ET AL.

Examiner

Bradley L. Sisson

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2009.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14-21, 23 and 24 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-12, 14-21, 23 and 24 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB06)
Paper No(s)/Mail Date 02 September 2009
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Drawings

1. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because:
 - a. The lettering is not of proper size, uniform density, and well-defined. See 37 CFR 1.84 (l) and (p)(1) – (5) (lettering must be at least 1/8 inch or 0.32 cm in height).
2. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

Replacement Drawing Sheets

Drawing changes must be made by presenting replacement sheets which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments section, or remarks, section of the amendment paper. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). A replacement sheet must include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and within the top margin.

Annotated Drawing Sheets

A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be submitted or required by the examiner. The annotated drawing sheet(s) must be clearly labeled as "Annotated Sheet" and must be presented in the amendment or remarks section that explains the change(s) to the drawings.

Timing of Corrections

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings MUST be filed within the THREE MONTH shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-12, 1q4-21, 23, and 24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.
5. As a result of amendment, claim 1, the sole independent claim, now recites the limitation that method steps a) through c) (of a method that only comprises steps a) through c)) is to be completed "in 90 minutes or less." Such a range in time has been construed as encompassing time periods of virtually instantaneous processing, hybridization and detection. The specification states at page 8, fifth paragraph: "Hybridization can be carried out under any

suitable technique known in the art.” A review of the art fails to identify where such a method, or even the hybridization step alone, is completed instantaneously.

6. Claims 2-12, 14-21, 23, and 24, which depend therefrom, fail to overcome this issue and are similarly rejected.

7. Claims 1-12, 14-21, 23, and 24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

8. As a result of amendment, claim 1, the sole independent claim, now recites the limitation that method steps a) through c) (of a method that only comprises steps a) through c)) is to be completed “in 90 minutes or less.” Such a range in time has been construed as encompassing time periods of virtually instantaneous processing, hybridization and detection. The specification states at page 8, fifth paragraph: “Hybridization can be carried out under any suitable technique known in the art.” A review of the art fails to identify where such a method, or even the hybridization step alone, is completed instantaneously. Accordingly, the aspect of performing the claimed method in an instantaneous manner is deemed to constitute new matter.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-12, 14-21, and 23-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Claim 1 recites the new limitation that the reaction “can be completed in 90 minutes or less.” It is unclear if this is limitation is a part of the claimed invention. See MPEP

§ 2173.05(d). Claims 2-12, 14-21, 23, and 24, which all depend from claim 1, fail to overcome this issue and are similarly rejected.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(c), (f) or (g) prior art under 35 U.S.C. 103(a).

15. Claims 1-12, 14-21, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admissions.

16. Attention is directed to MPEP 2129 [R-6], Admissions as Prior Art, which states in part:

I. ADMISSIONS BY APPLICANT CONSTITUTE PRIOR ART

A statement by an applicant >in the specification or made< during prosecution identifying the work of another as "prior art" is an admission **>which can be relied upon for both anticipation and obviousness determinations, regardless of whether the admitted prior art would otherwise qualify as prior art under the statutory categories of 35 U.S.C. 102. *Riverwood Int 'l Corp. v. R.A. Jones & Co.*, 324 F.3d 1346, 1354, 66 USPQ2d 1331, 1337 (Fed. Cir. 2003); *Constant v. Advanced Micro-Devices Inc.*, 848 F.2d 1560, 1570, 7 USPQ2d 1057, 1063 (Fed. Cir. 1988).

At page 11 of the response applicant asserts:

This application is not about a novel microarray technology platform. It is primarily about new methods of improving the speed and efficiency of bacterial detection by eliminating the nucleic acid purification step prior to hybridization on a diagnostic microarray.

Applicant, at page 7 of the specification admits:

A cell in a biological sample containing the target nucleic acid molecule can be lysed in a lysis buffer using any known methods, such as a physical method, a chemical method, a biological method, or any combination thereof.

Applicant, at page 9 of the specification admits:

Conditions those affect hybridization and those select against nonspecific hybridization are known in the art (Molecular Cloning A Laboratory Manual, second edition, J. Sambrook, E. Fritsch, T. Maniatis, Cold Spring Harbor Laboratory Press, 1989).

Applicant, at page 10 of the specification admits:

The oligonucleotide probes can be produced by any suitable method. For example, the probes can be chemically synthesized (See generally, Ausubel (Ed.) *Current Protocols in Molecular Biology*, 2.1 1. *Synthesis and purification of oligonucleotides*, John Wiley & Sons, Inc. (2000)), isolated from a natural source, produced by recombinant methods or a combination thereof. Synthetic oligonucleotides can also be prepared by using the triester method of Matteucci et al., *J. Am. Chem. Soc.*, 3 :3 1 85-3 1 9 1 (1 98 1).

Applicant, at page 13 of the specification, admits:

A microarray biochip containing a library of probes can be prepared by a number of well known approaches including, for example, light-directed methods, such as VLSIPSTM described in U.S. Patent Nos. 5,143,854, 5,384,261 or 5,561,071; bead based methods such as described in U.S. Patent No. 5,541,061; and pin based methods such as detailed in U.S. Patent No. 5,288,514. U.S. Patent No. 5,556,752, which details the preparation of a library of different double stranded probes as a microarray using the VLSIPSTM, is also suitable for preparing a library of hairpin probes in a microarray.

Flow channel methods, such as described in U.S. Patent Nos. 5,677,195 and 5,384,261, can be used to prepare a microarray biochip having a variety of different probes. In this case, certain activated regions of the substrate are mechanically separated from other regions when the probes are delivered through a flow channel to the support. A detailed description of the flow channel method can be found in U.S. Patent No. 5,556,752, including the use of protective coating wetting facilitators to enhance the directed channeling of liquids through designated flow paths.

Applicant, at page 15 of the specification, admits:

The probes can be attached to a support by means of a spacer molecule, e.g., as described in U.S. Patent No. 5,556,752 to Lockhart et al., to provide space between the double stranded portion of the probe as may be helpful in hybridization assays.

Applicant, at page 16 of the specification, admits:

Detection of hybridization between the probe and the target nucleic acids can be carried out by any method known in the art, e.g., labeling the probe, the secondary probe (or reporter), the target nucleic acids or some combination thereof, and are suitable for purposes of the present invention.

Applicant, at page 17 of the specification, admits:

Methods of labeling probes or nucleic acids are well known in the art.

Applicant, at page 21 of the specification, admits:

Secondary probe for indirect detection of hybridization can be also detected by energy transfer such as in the "beacon probe" method described by Tyagi and Kramer, *Nature* Biotech, u:303-309 (1 996) or U.S. Patent Nos. 5,119,801 and 5,312,728 to Lizardi et al. Any FRET detection system known in the art can be used in the present 5 method. For

In view of the admission by applicant that the method of lysing, hybridization, conditions that affect hybridization, probe synthesis, labeling and detection are all well known in the art, the claimed method is deemed to have been obvious to one of ordinary skill in the art at the time of applicant's invention.

17. To the degree that argument has been presented that the claimed method is an optimization over prior-art methods, it is well settled that routine optimization is not patentable, even if it results in significant improvements over the prior art. In support of this position, attention is directed to the decision in *In re Aller*, *Lacey*, and *Hall*, 105 USPQ 233 (CCPA 1955):

Normally, it is to be expected that a change in temperature, or in concentration, or in both, would be an unpatentable modification. Under some circumstances, however, changes such as these may impart patentability to a process if the particular ranges claimed produce a new and unexpected result which is different in kind and not merely in degree from the results of the prior art. *In re Dreyfus*, 22 C.C.P.A. (Patents) 830, 73 F.2d 931, 24 USPQ 52; *In re Waite et al.*, 35 C.C.P.A. (Patents) 1117, 168 F.2d 104, 77 USPQ 586. Such ranges are termed "critical" ranges, and the applicant has the burden of proving such criticality. *In re Swenson et al.*, 30 C.C.P.A. (Patents) 809, 132 F.2d 1020, 56 USPQ 372; *In re Scherl*, 33 C.C.P.A. (Patents) 1193, 156 F.2d 72, 70 USPQ 204. However, even though applicant's modification results in great improvement and utility over the prior art, it may still not be patentable if the modification was within the capabilities of one skilled in the art. *In re Sola*, 22 C.C.P.A. (Patents) 1313, 77 F.2d 627, 25 USPQ 433; *In re Normann et al.*, 32 C.C.P.A. (Patents) 1248, 150 F.2d 708, 66 USPQ

308; *In re Irmischer*, 32 C.C.P.A. (Patents) 1259, 150 F.2d 705, 66 USPQ 314. More particularly, where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Swain et al.*, 33 C.C.P.A. (Patents) 1250, 156 F.2d 239, 70 USPQ 412; *Minnesota Mining and Mfg. Co. v. Coe*, 69 App. D.C. 217, 99 F.2d 986, 38 USPQ 213; *Allen et al. v. Coe*, 77 App. D. C. 324, 135 F.2d 11, 57 USPQ 136. (Emphasis added)

18. For the above reasons, and in the absence of convincing evidence to the contrary, claims 1-12, 14-21, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admissions.

Conclusion

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

20. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley L. Sisson whose telephone number is (571) 272-0751.

The examiner can normally be reached on 6:30 a.m. to 5 p.m., Monday through Thursday.

22. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave T. Nguyen can be reached on (571) 272-0731. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bradley L. Sisson/
Primary Examiner, Art Unit 1634